



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/974,823

10/12/2001

Takashi Shimada

1086.1151

8256

21171 7590 05/05/2008

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

SWARTZ, JAMIE H

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/974,823	Applicant(s) SHIMADA ET AL.	
	Examiner JAMIE H. SWARTZ	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-10,12,13 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 7-10, 12-13, 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This action is in response amendment filed on January 4, 2008. Claims 1, 7, 8, 10, 12, and 13 have been amended. Claim 17 has been added. Claims 3-6, 11, 14-16 are cancelled. Claims 1-2, 7-10, 12-13, and 17 are currently pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-2, 7-10, 12-13 have been considered but are moot in view of the new ground(s) of rejection. Applicant also failed to address a 112, 2nd rejection made on claim 10.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 7-10, 12-13, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification includes contradictory statements. On page 1, lines 13-15, the specification states that "providing a business support service to the service beneficiary by way of a bank acting as the service beneficiary." Later on

page 5, lines 8-9 the applicant states “the service intermediary is a bank which has dealings with the service beneficiary.” The rest of the specification appears to refer to the banks as the intermediary and not the beneficiary. Thus making the scope of the invention unclear.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 7-10, 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 1 and 12, the phrases “providing said” and “receiving in” makes the claim indefinite because it is unclear who the results of the consultation are being received from and who the collected enterprise information is provided from.

8. Regarding claims 1, 12, and 13, the phrase “receiving in the computer of said service provider a result of the consultation to be provided to the computer of said service beneficiary from the computer of said intellectual service cooperator, sending said result from the computer of said service provider to the computer of said service intermediary...” renders the claim indefinite because the language of the claim makes the steps taken unclear. It appears that the results come from the cooperator, then sent to the service provider, then sent to the service intermediary, and finally to the

beneficiary. The language of the claim also allows the beneficiary to receive the results directly from the cooperator.

9. Regarding claim 10, the claim states “various settlements.” The word various makes the claim indefinite as various is not a specific term and does not attempt to limit the scope of the claim. Does the applicant mean many settlements? Settlements of different types?

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 9, 12, 13, 16 rejected under 35 U.S.C. 102(e) as being unpatentable over Broadbent et al (US 6904412 B1) in view of Malloy (October 20, 1997).

12. Regarding claim 1, 12, 13, Broadbent teaches a business management support method using computers of a service provider, a service beneficiary, a service intermediary, and an intellectual service cooperator attached to a network comprising *collecting enterprise information in the computer of said service provider from the computer of said service beneficiary* (col. 9, lines 8-20, col. 14, line 65 – col. 18, line 49,

Art Unit: 3694

col. 48, line 49 – col. 49, line 26). The borrower uses a computer to input their personal data (col. 9, lines 34-38). Broadbent teaches *providing said collected enterprise information collected by the computer of said service provider to the computer of said intellectual service cooperator to make a request for consultation* (col. 9, lines 19-30 and col. 14, lines 18-26). Broadbent teaches *receiving in the computer of said service provider a result of the consultation to be provided to the computer of said service beneficiary from the computer of said intellectual service cooperator, sending said result from the computer of said service provider to the computer of said service intermediary, tempering said result in the service intermediary with service intermediary business information from the computer of said service intermediary to create support information, and providing from the service intermediary said support information to the computer of said service beneficiary* (col. 12, lines 24-34 and col. 14, lines 18-26, col. 8, lines 23-45, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26).

Broadbent does Broadbent teaches how each party involved uses a computer (col. 14, lines 18-52). Malloy teaches an interconnection in communication within a consulting service. Including direct connections between a service provider, the service intermediary, the beneficiary and the service cooperator including adding in support information (pg. 1-8). Both Broadbent and Malloy disclose consulting methods. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Broadbent to include the specific details of the individual communications between each service provider. Since no consulting system exists in a vacuum there exists an obvious need for communication between the different aspects claimed in order to be part of the

Art Unit: 3694

system. These communication steps allow the beneficiary the chance to voice what services is needed, allows for the cooperator to return the information, and allows the intermediary a chance to include additional information.

13. Referring to claim 2, Broadbent teaches when a service intermediary is a bank which has dealings with said service beneficiary (col. 12, lines 24-34).

14. Referring to claim 9, while the specific names of the types of parties that would serve the intellectual service cooperator (i.e., an auditing corporation, a think tank, a securities firm, and a capital gain company) are not expressly disclosed by Broadbent, the specific names of the types of parties are mere labels. The particular names of the parties do not change the requesting or the information provided in claim 1 (from which claim 9 depends). As stated in claim 9, *an auditing corporation, a think tank, a securities firm and a capital gain company* are mere labels corresponding to the type of person performing the invention and such labels do not affect any recited structure or method. Analogous to the situation in *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) where structural limitations were not entitled to weight in method claims, the recited names of parties limitation therein must affect the method in a manipulative sense. In claim 9, since the recited names of parties does not affect the method in a manipulative sense, these specific names of parties do not patentably distinguish claim 9 over the prior art.

15. Referring to claim 12, Broadbent additionally teaches *a computer readable record medium having thereon recorded a business management support program to be run by a computer* (col. 7, lines 24-33). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

16. Referring to claim 13, Broadbent additionally teaches a computer that acts as *an information collecting unit, a requesting unit, and an information providing unit* (col. 6 line 15 – col. 7 line 44).

17. Referring to claim 16, Broadbent teaches *an application service provider (ASP) including an ASP server collecting enterprise information* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *a service beneficiary sending the enterprise information to said ASP server* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *an intellectual service cooperator including an intellectual service cooperating server, and receiving, in said intellectual service cooperating server, said enterprise information from said ASP server, and providing a consultation in accordance with the received enterprise information* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *a service intermediary including a bank server, and receiving, in said bank server, results of said consultation, and adding service*

information to the results, to create support information, and providing said support information to said service beneficiary (col. 17, line 26 – col. 18, line 55, col. 35, line 30 – 63, col. 48, line 60 – col. 49, line 13).

Regarding claim 17, Broadbent teaches collecting, by a service provider, enterprise information from a service beneficiary and defining a set of consulting services for the service beneficiary based on the collected enterprise information (col. 9, lines 8-20, col. 14, line 65 – col. 18, line 49, col. 48, line 49 – col. 49, line 26). Broadbent teaches requesting, by the service provider, consulting services from an intellectual service cooperator for the service beneficiary based on the set of defined consulting services and sending the collected enterprise information to the intellectual service cooperator for analysis (col. 9, lines 19-30 and col. 14, lines 18-26). Broadbent teaches analyzing, by the intellectual service cooperator, the collected enterprise information to form an analysis result and sending the analysis result to the service provider, wherein upon acceptance by the service provider of the analysis result, the service provider sends the analysis result to the service intermediary, the service intermediary adds transaction information between the service intermediary and the service beneficiary to the analysis result, and forwards the analysis result to the service beneficiary to form the basis of a consulting contract for the requested consulting services (col. 12, lines 24-34 and col. 14, lines 18-26, col. 8, lines 23-45, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26). Broadbent does Broadbent teaches how each party involved uses a computer (col. 14, lines 18-52). Malloy teaches an interconnection in communication

within a consulting service. Including direct connections between a service provider, the service intermediary, the beneficiary and the service cooperator including adding in support information (pg. 1-8). Both Broadbent and Malloy disclose consulting methods. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Broadbent to include the specific details of the individual communications between each service provider. Since no consulting system exists in a vacuum there exists an obvious need for communication between the different aspects claimed in order to be part of the system. These communication steps allow the beneficiary the chance to voice what services is needed, allows for the cooperator to return the information, and allows the intermediary a chance to include additional information.

18. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1) and Malloy (October 20, 1997), as applied to claim 1 above, in view of O'Flaherty et al (US 6253203 B1).

19. Regarding claim 7, Broadbent shows information collecting, requesting, consulting, and information providing but does not show predefined follow levels. O'Flaherty, however, shows a database *that depending on predefined follow levels, masking is effected in sequence on enterprise information collected in said collecting enterprise information, enterprise information provided to the computer of said intellectual service cooperator in providing said collected enterprise information, and said result on which the computer of said service beneficiary provided.* (col. 7, line 1 –

Art Unit: 3694

col. 10, line 55, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26)

Also see figures 2A-3C. O'Flaherty specifically discusses banking, mortgages (col. 1, line 57-67), financial information (col. 10, line 2-6), and the use of databases (col. 2, lines 53-56). O'Flaherty states his invention serves to prevent abuse associated with accessing personal customer information (col. 2, lines 30-40). Broadbent's invention is related to mortgage processing using databases. Similarly, O'Flaherty's invention is related to database security and references mortgages. It would have been obvious to a person of ordinary skill in the art at the time the invention to modify Broadbent to include the data column control for extra security with the information and for consumer privacy. This allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk as suggested by O'Flaherty.

20. Regarding claim 8, Broadbent shows information collecting, requesting, consulting, and information providing but does not show various follow levels or masking. O'Flaherty, however, shows different dataviews which are provide different levels of visibility into the data in the customer table using masking. The privileged view (col. 8, lines 35-50) is *when said follow level is a maximum level, said enterprise information and said result are completely indicated without masking, and wherein the standard view (col. 8, lines 5-34) is when said follow level is a minimum level, masking is made on attribute information other than requisite items in said enterprise information and said result, and wherein the anonymizing view (col. 9, lines 4-12) is when said*

Art Unit: 3694

follow level is a level lying between said maximum level and said minimum level, said attribute information is indicated partially or in a simplified manner. Broadbent's invention uses databases while O'Flaherty invention demonstrates a more sophisticated level of database security. Database security is more critical then ever now as networks have become more open. Database security exists as systems, processes, and procedures that protect a database from authorized misuse, malicious attacks or inadvertent mistakes made by authorized individuals or processes. Increased database security allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk. It would have been obvious to a person of ordinary skill in the art at the time the invention to adapt Broadbent to have a maximum and minimum level of security on the information in a database to protect their customer's information (as taught by O'Flaherty), especially since Broadbent handles very confidential finance data of their customers.

21. Claim 10 is rejected under 35 U.S.C. 102(e) as being unpatentable over Broadbent et al (US 6904412 B1) in view of Malloy (October 20, 1997) in further view of Official Notice.

22. Regarding claim 10, Broadbent teaches a business management support method with a service provider, a service beneficiary, a service intermediary and a service cooperator. Malloy teaches consulting services provided by individual companies.

Combined Broadbent and Malloy do not specifically teach a management diagnosis, support of going public business, publicity work, or settlements. However, Official Notice is taken that the use of a management diagnosis, support of going public business, publicity work, or settlements was old and well known in the art at the time of the invention. Consultants have gone into companies and analyzed management to improve their effectiveness. Consultants have given a company a battle plan for how and when to go public. Consultants have assisted with publicity work and supported various settlements. The first management consulting firm was opened over a century ago to help companies improve their performance.

23. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. H. S./
Examiner, Art Unit 3694

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694